

REMARKS/ARGUMENTS

Claims 1-40 are pending in the application. Claims 1-40 have been rejected.

A. Rejection of Claims 1-8, 10, 13-24, 26, and 29-38 Under 35 U.S.C. § 102

The Examiner rejected claims 1-8, 10, 13-24, 26, and 29-38 as being anticipated by Bennett et al., U.S. Pub. No. 2002/0112014 (hereinafter "Bennett"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (July 1998) (citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. § 2131 (July 1998) (citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Applicants respectfully assert that Bennett does not anticipate independent claims 1, 13, and 29 and therefore does not anticipate dependent claims 2-8, 10, 14-24, 26, and 30-38

Claims 1-8 and 10

Claims 1-8 and 10 provides "a messaging module comprising the instructions that are executable by the processor for ... providing to the user a message user interface to select a message from a plurality of preconfigured messages, wherein the messaging module receives the plurality of preconfigured messages from the message web site based on a user identification and displays the message user interface on the display thereby enabling the user to select the message from the plurality of preconfigured messages, and sending the message to the recipient through the global computer network." Nowhere in Bennett is a messaging module disclosed that includes these limitations.

On page 7 the Office Action, the Examiner incorrectly asserted that "as illustrated in Fig. 6, the method also includes a message user interface (e.g. web page) for ... *selecting message from the previously stored messages* that is, content retrieved from database 22 ([0069], [0071],

[0074]). Lastly, the method also includes routing or sending the message to the recipient”
(Italics added for emphasis).

Upon closer examination, Bennett does not disclose “a message user interface (e.g. web page) for ... *selecting message from the previously stored messages* that is, content retrieved from database 22” or the similar elements of claims 1-8 and 10. Office Action page 7. In paragraph [0069], Bennett only describes that “different devices may be identified ... in incoming messages to a server. ... Selection of a particular format and data sent to a particular device may be made by the server in accordance with received device specific information.” In paragraph [0071], Bennett only describes that a user may “register and or send messages using the server” and that “a country specific format of an associated mobile identification number (MIN) when sending a message” may be obtained from the routing database. In paragraph [0074], Bennett only describes that “Field 81 outlines those portions of information which may be entered,” and that “the user’s name, the recipient’s name, and recipient’s country may be, for example, alphanumeric characters.”

Applicants respectfully assert that Bennett does not set forth each and every element of the claims 1-8 and 10. Specifically, Bennett fails to set forth the elements of “the messaging module receives the plurality of preconfigured messages from the message web site based on a user identification and displays the message user interface on the display thereby enabling the user to select the message from the plurality of preconfigured messages, and sending the message to the recipient through the global computer network.” Therefore, Bennett does not anticipate claims 1-8 and 10 and withdrawal of this rejection is respectfully requested.

Claims 13-24 and 26

Claims 13-24 and 26 provides “sending a plurality of preconfigured messages ... from the web site to the wireless device, receiving a message ... from the wireless device, wherein the message is selected from the preconfigured messages by a user through the wireless device, and ... sending the message to the recipient through the global computer network.” Applicants respectfully assert that Bennett fails to disclose or set forth these elements of claims 13-24 and 26.

In the Office Action on page 4, the Examiner incorrectly asserted that “Bennett further discloses sending a plurality of pre-configured (pre-packaged) ([0103]) messages identified through use of the user identification from the web site to the wireless device ([0037], [0103], [0189])” and that “Bennett also discloses a message user interface (e.g. web page) for ... selecting message from the previously stored messages, that is, content retrieved from database 22 ([0069], [0071], [0074]).” As noted above, paragraphs [0069], [0071], and [0074] do not describe “a message user interface (e.g. web page) for ... selecting message from the previously stored messages, that is, content retrieved from database 22.” Office Action page 4.

Paragraph [0037] only sets forth “the message may be routed to the server 24 to obtain information for appropriately routing the message using database 22.” Paragraph [0103] discloses “‘content’ refers to ‘pre-packaged’ information such as stock quotes or weather.” Finally, paragraph [0189] discloses “a user may obtain information” from a server or access applications. However, none of these paragraphs disclose, set forth, teach, or suggest “sending a plurality of preconfigured messages ... from the web site to the wireless device, receiving a message ... from the wireless device, wherein the message is selected from the preconfigured messages by a user through the wireless device, and ... sending the message to the recipient through the global computer network” Therefore, Bennett does not anticipate each and every element of claims 13-24 and 26. Thus, Applicants respectfully request withdrawal of this rejection.

Claims 29-38

Claims 29-38 provides “retrieving the preconfigured messages from the web site based on a user identification, sending the preconfigured messages to the wireless device, providing to the user a message user interface to select a message from the preconfigured messages, and sending the message to the recipient through the global computer network.” Nowhere in Bennett is each and every element of claims 29-38 set forth.

As noted above, the Examiner on page 7 of the Office Action incorrectly asserted that “as illustrated in Fig. 6, the method also includes a message user interface (e.g. web page) for ... *selecting message from the previously stored messages* that is, content retrieved from database 22 ([0069], [0071], [0074]). Lastly, the method also includes routing or sending the message to

the recipient” (italics added for emphasis). Upon closer examination and as noted and summarized above however, paragraphs [0069], [0071], [0074] of Bennett do not describe or set forth “a message user interface (e.g. web page) for ... selecting message from the previously stored messages that is, content retrieved from database 22.” Office Action page 7.

None of the paragraphs cited by the Examiner or any part of Bennett set forth, disclose, or even suggest each and every element of claims 29-38, such as “sending the preconfigured messages to the wireless device, providing to the user a message user interface to select a message from the preconfigured messages, and sending the message to the recipient through the global computer network.” Therefore, the Bennett et al. fails to anticipate claims 29-38 and withdrawal of this rejection is respectfully requested.

B. Rejection of Claims 9, 11, 12, 25, 27, 28, 39 and 40 Under 35 U.S.C. § 103

The Examiner rejected claims 9, 11, 12, 25, 27, 28, 39 and 40 as being unpatentable over Bennett in view of Gargiulo et al., U.S. Pub. No. 2002/0087656 (hereinafter “Gargiulo”). Applicants respectfully assert that a *prima facie* case of obviousness has not been established and that claims 9, 11, 12, 25, 27, 28, 39 and 40 are patentable over Bennett in view of Gargiulo. M.P.E.P. 2142 requires that “the prior art reference (or references when combined) must teach or suggest all the claim limitations” to establish a *prima facie* case of obviousness.

As noted above, Bennett fails to teach or suggest each and every element of independent claims 1, 13, and 29. The Examiner noted in the Office Action on page 9 that “Gargiulo discloses message communication in wireless networks via a network [and] ... discloses one or other mark-up languages such as XHTML ([0025]), HDML ([0040]), and XML ([0040]).” However, Gargiulo similarly fails to teach or suggest each and every element of independent claims 1, 13, and 29. Specifically, Gargiulo fails to teach the same elements discussed above as Bennett. Therefore, claims 9, 11, 12, 25, 27, 28, 39 and 40 are patentable over Bennett in view of Gargiulo and Applicants respectfully request withdrawal of this rejection.

Appl. No. 09/928,856
Amdt. dated August 3, 2004
Reply to Office Action of May 3, 2004

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant(s)

Date: August 3, 2004

MADSON & METCALF
Gateway Tower West
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: 801/537-1700